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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/138,218 | 08/21/1998 | MIKA TARKIAINEN | 466-008195-U | 3829 |

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03/13/2002

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EXAMINER

GESESSE, TILAHUN

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/138,218

Applicant(s)

TARKIAINEN ET AL.

Examiner

Tilahun B Gesesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2,4-6,8-15 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pepe et al (US Pat. No.5,742,905)..

As to claims 1-2,4,6,9-12, 14-15 and 18, Pepe et al disclose method for the transmission of user messages (consumer, an office for example, has various messaging equipments, such as voice mail system²⁰, an e-mail terminal 22, fax machine 24 and telephones 26 coupled to a personal communications internetworking (PCI)) using a message service(SMS server 46) to the mobile station of a recipient, who has a primary mobile station(a cellular phone 32) capable of receiving at least voice calls and user messages, (the mobile communications subscriber can receive e-mail, fax, pages and voice messages under a single phone number while using either a wireless or wireline networks, see col. 5 lines 54-62 and fig.3), comprising the step of :

Directing user messages addressed to the primary mobile station (32) to any of the secondary mobile stations of the recipient, irrespective of whether the primary mobile station is in use (PDA 30 and pager 34, see fig.3 and further more, Pepe et al disclose the subscriber may have notification of voice mail or fax message receipt directed to a wireless PDA in the form of e-mail messages. If the subscriber's wireless PDA is not turned on or otherwise, not operation.

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The notification may be routed to an alternate wireless or wireline network, see col. 6 lines 11-19).

As to claims 5,8,13 and 17, Pepe et al disclose using a data computing device (PDA) of the recipient for informing of a received user message to the recipient and to acknowledge the received user message by the recipient, and first directing the received user message to the data computing device and , if the user message is not acknowledged by a determined time, forwarding the user message to the activated mobile station, see col.21 lines 45-63.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3,7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al in view of Pepper et al (US 5,930,700).

As per claims 3,7 and 16, Pepe et al fail to disclose the user messages are generated on the basis of the notification of calendar events. However, Pepper et al disclose the subscriber uses the GUI to enter in his daily schedule and his list of clients. The GUI also alerts the subscriber when the service control module 306 communicates with the PDA about new pending messages and to determine if the subscriber wants to accept a given call or forward it on to the voice mail portion of the service control. The database 308 maintains a network copy of the subscriber's daily schedule and client list which are used, along with the subscriber's default profile, to determine which calls to forward directly to the subscriber at his current location, which calls to forward to the subscriber's voice mail box, and when to let the subscriber decide what to do with a particular call, see col.5-6 lines 66-68 and 1-11 respectively. Therefore, therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify to notify the calendar events for Pepe with pepper so that the notification user message forward to the alternative communication device based on time or schedule of the user.

Response to Arguments

7.. Applicant's arguments filed 01/08/02 have been fully considered but they are not persuasive for the following reasons:

Applicant argued that the prior art "Pepe is filed in 1994, those of skill in the art would appreciate that in 1994 the cellular phone, the pager, and PDA were quite different devices from those in use today, page 6 lines 9-12.

However, applicants' claims do not show or are not specific to how differently handle user message today other than the teaching of prior art.

Applicant argued that Pep et al teach that a notification not the message per se, page 6 lines 22-23.

However, Pepe et al disclose notify a user by redirecting notification that is text message , (abstract) and Pepe et al disclose a text messaging technique which is in other words a short messaging service. Examiner disagrees that applicant's argument is persuasive and rejection is maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thro et al disclose when the recipient of a call or page does not answer the call or page , many options exist for the recipient to redirect a call or otherwise use another service such that the recipient is made aware of the call (col.1 lines 38-42).

10. *Any response to this action should be mailed to:*

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun Gesesse whose telephone number is (703) 308-5873.. The examiner can normally be reached on Monday-Thursday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost, can be reached on (703) 308-5318. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

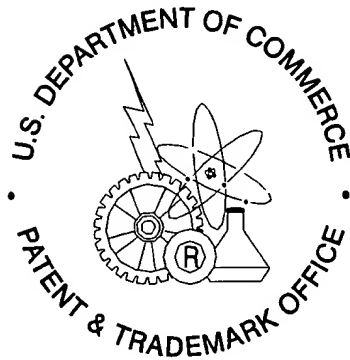
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TBG

Feb, 26, 2002

Tilahun Gesesse
Patent Examiner
Art unit 2685



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